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Rupert Christian Scheiner

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CONNOLLY BOVE LODGE & HUTZ LLP

1875 EYE STREET, N.W.

SUITE 1100

WASHINGTON, DC 20006

EXAMINER

BAYS, PAMELA M

ART UNIT

PAPER NUMBER

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/516,891	<b>Applicant(s)</b> SCHEINER, RUPERT CHRISTIAN	
	<b>Examiner</b> Pamela M. Bays	<b>Art Unit</b> 3766	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-10, 12 and 15-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-10, 12, and 15-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>30 November 2009</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03 November 2009 has been entered.
2. This Office Action is responsive to the Amendment filed in the Request for Continued Examination on 03 November 2009. As directed by the Amendment: Claims 1-6, 8-10, 12, 15-19, 21-22, and 24 have been amended, Claims 7, 11, and 13-14 have been cancelled, and no claims have been added. Thus, Claims 1-6, 8-10, 12, 15-29 are presently pending in this Application.
3. The Amendment to the Title is accepted by the Examiner.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. ***Claims 1-6, 8-10, 12, 15-18, and 21-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.***

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6. Claim 1 recites, “configured to receive releasably engage” in Line 6. It appears that the word “receive” was erroneously included. Appropriate correction is required.

Claims 2-6, 8-10, 12, and 15-18 are rejected for being dependent on Claim 1.

7. Claims 21, 22, and 24 recite, “An external component of a partially implantable medical device, the external component comprising..” in the preamble. The scope of the limitation “partially implantable” is unclear, especially since only the external components are being claimed. Claims 23 and 25-29 are rejected for depending on rejected Claims 21, 22, and 24.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

***9. Claims 1-6, 8-10, 12, and 15-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liautaud (US Patent No. 4,322,585, previously cited) in view of de Jong (US Patent No. 4,280,256, previously cited).***

10. Regarding Claims 1-4, and 12, Liautaud discloses a clothing attachment device for an external component of a hearing prosthesis (Abstract), the attachment device comprising an elongate pin member integrally connected to (Col. 2, Lines 40-45) and extending outwardly from a casing to a distal end (Fig. 3), adapted to pass through at least a portion of an item of clothing (Fig. 3); an engagement housing (Fig. 5) having disposed therein a plurality of non-spherical, metallic (“conductive”, inherently metallic,

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Col. 2, Lines 53-60) engagement members (32, 38, 39) collectively adapted to receive at least a portion of the elongate member and releasably engage with said engagement members (Fig. 5, Col. 2, Lines 45-65); and an unlocking device configured to release said elongate member from said non-spherical engagement members when said elongate member is engaged to said engagement members (Col. 2, Lines 60-65), wherein at least one of said elongate member and said receiving engagement housing is configured to be mounted to the external component (Fig. 3), but does not disclose that the engagement housing has a plurality of magnetic non-spherical members disposed in the engagement housing and configured to releasably engage at least a portion of the elongate member, and a magnetic unlocking device configured to apply a magnetic field to the non-spherical engagement member to release the elongate member when the magnetic unlocking device is in proximity to said non-spherical members. De Jong discloses a faster with a head and an elongate member that is intended to pierce an article of clothing (Fig. 1, Col. 1, Lines 1-30), with magnetic members disposed in a circular arrangement (Figs. 2-3) within a non-magnetic chamber (chamber is hollow, therefore inherently non-magnetic), wherein a spring 13 is adapted to urge the plate 14 against the members within the chamber (Fig. 1), and wherein the members frictionally engage the pin member in a chamber (Fig. 1), and wherein the engagement of the pin being releasable by a magnetic unlocking device acting on said plurality of magnetic members and having a magnetic field of a strength sufficient to overcome the bias provided on the members by the spring and so cause the members to move rearwardly relative to the chamber ("removed by a special apparatus which

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comprises a strong magnet for pulling the balls clear of the pin," Col. 1, Lines 22-30). It would have been obvious to one having ordinary skill in the art at the time of the invention to use any known engagement means such as magnetic members to releasably engage the pin member as taught by de Jong, in the hearing device disclosed by Liautaud, in order to securely lock the pin, and unlock it only with a special tool, and because Liautaud discloses that in this device, "many types of retaining clips may be employed" (Col. 2, Lines 50-53), and "mechanical details for the engagement members may vary since these ... are well known" (Col. 2, Lines 60-65). Furthermore, it would have been an obvious matter of design choice to have the members as disclosed by De Jong be made non-spherical, for the purpose of fitting them within the engagement housing, since such a modification would have involved a mere change in the form or shape of a component. A change in form or shape is generally recognized as being within the level of ordinary skill in the art. In re Dailey, 149 USPQ 47 (CCPA 1976).

11. Regarding Claim 5, Liautaud discloses a clothing attachment device further wherein the elongate member comprises a head and a pin member extending from the head to a distal end (Figs. 3 and 5, head is where the pin connects to the casing).

12. Regarding Claims 6 and 8, Liautaud discloses a clothing attachment device further wherein the engagement housing is mounted to a casing of the external component (Fig. 3, housing 32 is mounted to casing by engaging with the pin), and further wherein the engagement housing comprises an orifice extending into the engagement housing (Fig. 5) from a front surface thereof, the orifice being able to

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receive at least a portion of the length of the elongate member (Col. 2, Lines 40-50), wherein the orifice extends from the front surface to a chamber within the engagement housing (Figs. 3, 5).

13. Regarding Claim 9, Liautaud discloses a clothing attachment device further wherein the chamber of the engagement housing has a inner wall of which at least a portion thereof is frusto-conical such that the chamber expands in diameter away from the front surface of the engagement housing (Fig. 5, engagement means and chamber expand outward conically).

14. Regarding Claim 10, Liautaud discloses a clothing attachment device further comprising a pin engagement mechanism that frictionally engages the pin member on insertion of the pin member through the orifice and into the chamber (Fig. 5, Col. 2, Lines 40-60).

15. Regarding Claim 15, Liautaud discloses a clothing attachment device further wherein the engagement members are normally biased in an engaging configuration within the chamber (Fig. 5, spring push engagement members against the pin), wherein a biasing means (the spring) is positioned within the chamber which, when in its relaxed condition, displaces the plurality of engagement members (38, 39) towards the front surface of the engagement housing and into the engaging configuration (Fig. 5).

16. Regarding Claim 16, Liautaud discloses a clothing attachment device further wherein the biasing means is a spring and plate (Fig. 5), the spring being mounted between a rearward end of the chamber and the plate, and the plate being mounted to a

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forward end of the spring (tip of plates engage the pin, which are biased by the springs, Fig. 5).

17. Regarding Claims 17 and 19, Liautaud discloses an external component of a medical device (Abstract, an electronic listening system could be medically necessary), the external component comprising at least one processor ("transducer," Col. 2, Lines 30-45) of said medical device disposed adjacent a casing; an engagement housing having disposed therein a plurality of non-spherical engagement members (38, 39) and mounted to the casing (Figs. 3 and 5, housing 32 is mounted to casing by engaging with the pin); and an elongate member adapted to pass through at least a portion of an item of clothing and be received in the engagement housing and releasably engage with said engagement members (Abstract, Fig. 5, Col. 2, Lines 45-55); wherein the engagement of said elongate member and said engagement housing is releasable by an unlocking device ("finger release tabs", Col. 2, Lines 59-65), but does not disclose that the engagement housing has a plurality of magnetic non-spherical members disposed in the engagement housing and configured to releasably engage at least a portion of the elongate member, and a magnetic unlocking device configured to apply a magnetic field to the non-spherical engagement member to release the elongate member when the magnetic unlocking device is in proximity to said non-spherical members. De Jong discloses a faster with a head and an elongate member that is intended to pierce an article of clothing (Fig. 1, Col. 1, Lines 1-30), with magnetic members disposed in a circular arrangement (Figs. 2-3) within a non-magnetic chamber (chamber is hollow, therefore inherently non-magnetic), wherein a spring 13 is adapted to urge the plate 14



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against the members within the chamber (Fig. 1), and wherein the members frictionally engage the pin member in a chamber (Fig. 1), and wherein the engagement of the pin being releasable by a magnetic unlocking device acting on said plurality of magnetic members and having a magnetic field of a strength sufficient to overcome the bias provided on the members by the spring and so cause the members to move rearwardly relative to the chamber ("removed by a special apparatus which comprises a strong magnet for pulling the balls clear of the pin," Col. 1, Lines 22-30). It would have been obvious to one having ordinary skill in the art at the time of the invention to use any known engagement means such as magnetic members to releasably engage the pin member as taught by de Jong, in the hearing device disclosed by Liautaud, in order to securely lock the pin, and unlock it only with a special tool, and because Liautaud discloses that in this device, "many types of retaining clips may be employed" (Col. 2, Lines 50-53), and "mechanical details for the engagement members may vary since these ... are well known" (Col. 2, Lines 60-65). Furthermore, it would have been an obvious matter of design choice to have the members as disclosed by De Jong be made non-spherical, for the purpose of fitting them within the engagement housing, since such a modification would have involved a mere change in the form or shape of a component. A change in form or shape is generally recognized as being within the level of ordinary skill in the art. In re Dailey, 149 USPQ 47 (CCPA 1976).

18. Regarding Claim 22, Liautaud discloses an external component of a medical device (Abstract, an electronic listening system could be medically necessary), the external component comprising at least one processor of said medical device disposed

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adjacent a casing ("transducer," Col. 2, Lines 30-45); an elongate member extending outwardly from the casing and adapted to pass through at least a portion of an item of clothing (Fig. 5); and a receiving means adapted to receive at least a portion of the elongate member and releasably engage therewith (Fig. 5, Col. 2, Lines 45-60); wherein the engagement of said elongate member and said receiving means is releasable by an unlocking device ("finger release tabs", Col. 2, Lines 59-65), but does not disclose that the engagement housing has a plurality of magnetic members disposed in the engagement housing and configured to releasably engage at least a portion of the elongate member, and a magnetic unlocking device configured to apply a magnetic field to the engagement members to release the elongate member when the magnetic unlocking device is in proximity to said members. De Jong discloses a faster with a head and an elongate member that is intended to pierce an article of clothing (Fig. 1, Col. 1, Lines 1-30), with magnetic members disposed in a circular arrangement (Figs. 2-3) within a non-magnetic chamber (chamber is hollow, therefore inherently non-magnetic), wherein a spring 13 is adapted to urge the plate 14 against the members within the chamber (Fig. 1), and wherein the members frictionally engage the pin member in a chamber (Fig. 1), and wherein the engagement of the pin being releasable by a magnetic unlocking device acting on said plurality of magnetic members and having a magnetic field of a strength sufficient to overcome the bias provided on the members by the spring and so cause the members to move rearwardly relative to the chamber ("removed by a special apparatus which comprises a strong magnet for pulling the balls clear of the pin," Col. 1, Lines 22-30). It would have been obvious to one

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having ordinary skill in the art at the time of the invention to use any known engagement means such as magnetic members to releasably engage the pin member as taught by de Jong, in the hearing device disclosed by Liautaud, in order to securely lock the pin, and unlock it only with a special tool, and because Liautaud discloses that in this device, "many types of retaining clips may be employed" (Col. 2, Lines 50-53), and "mechanical details for the engagement members may vary since these ... are well known" (Col. 2, Lines 60-65). Furthermore, the limitation, "a partially implantable medical device" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

19. Regarding Claim 24, Liautaud discloses an external component of a medical device (Abstract, an electronic listening system could be medically necessary), the external component comprising an elongate member (36, Fig. 5); at least one processor of said medical device disposed in said external device ("transducer," Col. 2, Lines 30-45); a retaining means for frictionally retaining at least one portion of the elongate member in a first configuration and for releasing the at least one portion in a second configuration (opened and closed tabs, Fig. 5, Col. 2, Lines 52-65); and a biasing means (springs, Fig. 5) for biasing the retaining means into the first configuration (Fig.

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5); wherein the retaining means is incorporated into the external component (attached together through pin and engagement features, Figs. 1, 3, 4) to enable the external component to be fastened to an item of clothing worn by a user of the external component (Abstract), when the retaining means is frictionally retaining the said at least one portion of the elongate member (Fig. 5, Col. 2, Lines 45-65), but does not disclose that the engagement device has a plurality of magnetic spheres disposed in a circular arrangement within a non-magnetic chamber, and wherein the spring is adapted to urge the plate against the spheres within the chamber; wherein an orifice is formed in the engagement device to enable entry of the pin member into the chamber and thereafter frictionally engage with the plurality of spheres, the engagement of the pin being releasable by a magnet acting on said plurality of magnetic spheres and having a magnetic field of a strength sufficient to overcome the bias provided on the spheres by the spring and so cause the spheres to move rearwardly relative to the chamber. De Jong discloses a faster with a head and an elongate member that is intended to pierce an article of clothing (Fig. 1, Col. 1, Lines 1-30), with magnetic spheres disposed in a circular arrangement (Figs. 2-3) within a non-magnetic chamber (chamber is hollow, therefore inherently non-magnetic), wherein a spring 13 is adapted to urge the plate 14 against the spheres within the chamber (Fig. 1), and wherein the spherical members frictionally engage the pin member in a chamber (Fig. 1), and wherein the engagement of the pin being releasable by a magnet acting on said plurality of magnetic spheres and having a magnetic field of a strength sufficient to overcome the bias provided on the spheres by the spring and so cause the spheres to move rearwardly relative to the

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chamber ("removed by a special apparatus which comprises a strong magnet for pulling the balls clear of the pin," Col. 1, Lines 22-30). It would have been obvious to one having ordinary skill in the art at the time of the invention to use any known engagement means such as magnetic spheres to releasably engage the pin member as taught by de Jong, in the hearing device disclosed by Liautaud, in order to securely lock the pin, and unlock it only with a special tool, and because Liautaud discloses that in this device, "many types of retaining clips may be employed" (Col. 2, Lines 50-53), and "mechanical details for the engagement members may vary since these ... are well known" (Col. 2, Lines 60-65). In *re Dailey*, 149 USPQ 47 (CCPA 1976). Additionally, the limitation, "a partially implantable medical device" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

20. Regarding Claim 25, Liautaud discloses an external component further wherein the elongate member is releasable from the retaining means by momentarily counteracting the biasing means to cause the retaining means to assume the second configuration (finger release tabs cause engagement members to momentarily release the pin in the second open configuration, Col. 2, Lines 45-65), wherein the biasing means are spiral springs (Fig. 5).

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21. Regarding Claims 21, 26, 27, 28, Liautaud discloses all of the claimed elements as described above, including an external component of a medical device (Abstract, an electronic listening system could be medically necessary), the external component comprising at least one processor of said medical device disposed adjacent a casing ("transducer," Col. 2, Lines 30-45); an elongate member having a pin member adapted to pass through at least a portion of an item of clothing (Fig. 5); with a chamber having an inner wall, of which at least a portion is frusto-conical such that the chamber expands in diameter away from a front surface of the engagement device (Fig. 5), the pin engagement device also having a spiral spring acting and mounted between a rearward end of the chamber and a plate (Fig. 5), but does not disclose that the engagement device has a plurality of magnetic spheres disposed in a circular arrangement within a non-magnetic chamber, and wherein the spring is adapted to urge the plate against the spheres within the chamber; wherein an orifice is formed in the engagement device to enable entry of the pin member into the chamber and thereafter frictionally engage with the plurality of spheres, the engagement of the pin being releasable by a magnet acting on said plurality of magnetic spheres and having a magnetic field of a strength sufficient to overcome the bias provided on the spheres by the spring and so cause the spheres to move rearwardly relative to the chamber. De Jong discloses a faster with a head and an elongate member that is intended to pierce an article of clothing (Fig. 1, Col. 1, Lines 1-30), with magnetic spheres disposed in a circular arrangement (Figs. 2-3) within a non-magnetic chamber (chamber is hollow, therefore inherently non-magnetic), wherein a spring 13 is adapted to urge the plate 14 against the spheres within the chamber (Fig.

1), and wherein the spherical members frictionally engage the pin member in a chamber (Fig. 1), and wherein the engagement of the pin being releasable by a magnet acting on said plurality of magnetic spheres and having a magnetic field of a strength sufficient to overcome the bias provided on the spheres by the spring and so cause the spheres to move rearwardly relative to the chamber ("removed by a special apparatus which comprises a strong magnet for pulling the balls clear of the pin," Col. 1, Lines 22-30). It would have been obvious to one having ordinary skill in the art at the time of the invention to use any known engagement means such as magnetic spheres to releasably engage the pin member as taught by de Jong, in the hearing device disclosed by Liautaud, in order to securely lock the pin, and unlock it only with a special tool, and because Liautaud discloses that in this device, "many types of retaining clips may be employed" (Col. 2, Lines 50-53), and "mechanical details for the engagement members may vary since these ... are well known" (Col. 2, Lines 60-65). In *re* Dailey, 149 USPQ 47 (CCPA 1976). Additionally, the limitation, "a partially implantable medical device" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

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22. Regarding Claims 18, 20, 23, and 29, Liautaud discloses a hearing prosthesis wherein an external portion is removably clipped to the user's clothing, and all of the other claimed elements as described above, except wherein the hearing prosthesis is a cochlear implant. However, it is well known in the art that the external parts of cochlear implants are commonly attached to the user's clothing and even the Applicant's Specification states, "the external speech processor unit is typically... removably clipped on the clothing" (Paragraph 4, Fig. 1). It would have been obvious to one having ordinary skill in the art at the time of the invention to use the fastening means as described by Liautaud or de Jong as a secure fastening means for a cochlear implant, because it would have been obvious to use any known removable fastening means to achieve the same function as the clips for cochlear implants that are well-known in the art.

### ***Response to Arguments***

23. Applicant's arguments filed in the Request for Continued Examination filed 03 November 2009 have been fully considered but they are moot in view the new grounds of rejection necessitated by the Applicant's Amendment.

24. With respect the Applicant's arguments regarding the use of the fastening mechanisms disclosed by de Jong and Liautaud in a partially implantable cochlear implant, these arguments are not found persuasive due to the following reasons.

25. In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning in using any type of known fastener in a cochlear implant, it must be recognized that any judgment on obviousness



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is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. The Applicant admitted that pins and fasteners to connect cochlear implants were well known in the art, and thus it would have been well-known to use any known type of fastener, such as ones disclosed by Liautaud or de Jong. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

26. Furthermore, recitation of "medical device" occurs in the preamble, the dependent Claims 18, 20, 23, and 29 reciting a "wherein the medical device is a cochlear implant," these limitations are given less patentable weight, because recitation of a 'cochlear implant' is a recitation of an intended use of the clip mechanism. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

**27. If the Applicant wishes to overcome the de Jong and Liautaud references, additional structure of the cochlear implant must be moved out of the dependent claims and into the body of the independent claims, thus actually claiming more than a specific fastening mechanism with an intended use medical function.**

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela M. Bays whose telephone number is (571) 270-7852. The examiner can normally be reached on Monday-Friday, 9am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl H. Layno can be reached on (571) 272-4949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carl H. Layno/  
Supervisory Patent Examiner, Art Unit 3766

/P. B./  
Examiner, Art Unit 3766